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PATENT

Docket No. 2880/323



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : Martti TALJA et al.  
Serial No. : 09/737,765 (Continuation of 08/304,082)  
Filed : December 18, 2000  
For : BIODEGRADABLE SURGICAL IMPLANTS AND DEVICES  
Group Art Unit : 3308 (Anticipated)  
Examiner : D. Isabella (Anticipated)

Assistant Commissioner  
for Patents  
Washington, D.C. 20231

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Attention: Office of Petitions  
Special Programs Law Office

OFFICE OF PETITIONS

**Petition Under 37 C.F.R. § 1.53(e)  
And Authorization to Charge Rule 1.17(i) Fee to Deposit Acct. No. 11-0600**

S I R :

In response to the Notice of Omitted Item(s) in a Nonprovisional Application dated January 29, 2001, which was issued by the Initial Patent Examination Division regarding the above-referenced continuation application, Applicants submit this petition under 37 C.F.R. §1.53(e) for a review of the determination that Figures 19, 20, 21 and 22 described in the specification were omitted from the specification of this application as filed on December 18, 2000. As demonstrated below, the instant continuation application (Appl. Serial No. 09/737,765), by way of a transmittal letter on filing and a concurrently-filed preliminary amendment, incorporated by reference the entirety of the disclosure of its parent application (Serial No. 08/304,082), which included Figures 19, 20, 21 and 22. Therefore, by way of this petition, Applicants respectfully request that the Notice of Omitted Item(s) in a Nonprovisional Application be withdrawn.

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This petition is timely filed, as it is being filed on March 29, 2001, which is precisely two months after the January 29, 2001 mailing date of the Notice of Omitted Item(s) in a Nonprovisional Application.

#### **Evidence and Argument Supporting Withdrawal of Notice**

In accordance with the provisions of 37 C.F.R. §1.53(e), Applicants petition that the Notice of Omitted Item(s) in a Nonprovisional Application be withdrawn.

On December 18, 2000, Applicants filed this continuation application that claimed priority under 35 U.S.C. § 120 from co-pending Application Serial No. 08/304,082, which subsequently issued on January 9, 2001 as U.S. Patent No. 6,171,338 (attached hereto as Exhibit 1). The continuation application filed on December 18, 2000 contained 11 pages of drawings, including Figures 1 through 18, and expressly incorporated by reference the entire disclosure of Application Serial No. 08/304,082 (which includes Figures 1 through 18 *and Figures 19 through 22*, as shown in Exhibit 1 hereto). On August 10, 2000, Applicants received a "Notice of Omitted Item(s) in a Nonprovisional Application," stating that Figures 19, 20, 21 and 22 were missing from the continuation application.

The Notice of Omitted Item(s) in a Nonprovisional Application should be withdrawn since each of Figures 19, 20, 21 and 22 were properly incorporated by reference in the continuation application. Applicants enclose herewith copies of Figures 19, 20, 21 and 22 for express inclusion with the continuation application on withdrawal of the Notice. While included in the continuation application by way of incorporation by reference to Application Serial No. 08/304,082,

Applicants have properly incorporated by reference into this continuation application the entirety of the disclosure of the copending parent application Serial No. 08/304,082 (now U.S. Patent 6,171,338, Exhibit 1 hereto). Specifically, as set forth in the Preliminary Amendment (attached hereto as Exhibit 2) filed concurrently with this continuation application on December 18, 2000, page 1, line 5 of the specification of this continuation application reads "This application is a continuation of Application Serial No. 08/304,082, filed September 6, 1994, which is a continuation-in-part of U.S. Patent Application Serial No. 07/681,529, filed July 9, 1991, *the entire disclosures of which are hereby incorporated by reference.*" Exhibit 2 hereto (emphasis added). Likewise, the Transmittal of this continuation application (attached hereto as Exhibit 3) expressly states

that "The entire disclosure of the prior application [i.e., Appl. Serial No. 08/304,082] . . . is considered a part of the accompanying or divisional application and is hereby incorporated by reference." Exhibit 3 hereto.

Figures 19, 20, 21 and 22 described in the instant continuation application are identical to Figures 19, 20, 21 and 22 described and presented in the referenced parent Application Serial No. 08/304,082. *Compare* copies of Figures 19, 20, 21 and 22 enclosed herewith with Figures 19, 20, 21 and 22 of U.S. Patent No. 6,171,338 (Exhibit 1 hereto), which issued from parent Appl. Serial No. 08/304,082. Accordingly, Figures 19, 20, 21 and 22 were properly incorporated by reference into the instant continuation application from the parent Appl. Serial No. 08/304,082. In this regard, Applicants respectfully bring the Examiner's attention to the M.P.E.P., Section 608.01(p) which states that an application for a patent when filed may incorporate "essential material" by reference to a pending U.S. application.


The undersigned respectfully requests that the Patent Office (1) grants the 1.53(e) petition on its merits; (2) withdraws the Notice of Omitted Item(s) in a Nonprovisional Application; and (3) accepts enclosed Figures 19, 20, 21 and 22 as properly incorporated by reference in the instant continuation application as of the filing date of December 18, 2000.

**The Commissioner is hereby authorized to charge the 1.53(e) petition fee of \$130.00 (pursuant to Rule 1.17(i)) to Deposit Account No. 11-0600. If there are any additional fees, the Commissioner is also authorized to charge such fees to the same account. A copy of this response is enclosed for charging purposes.**

Respectfully submitted,

KENYON & KENYON

Date: 3/29/01

  
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